

**REMARKS/ARGUMENTS**

Claims 24-31 are pending. By this Amendment, claims 25, 26 and 30 are amended for clarity only to obviate a minor typographical error. Reconsideration in view of the above amendments and the following remarks is respectfully requested.

Claim 25 was objected to based on an informality noted by the Examiner in line 7. By this Amendment, the informality has been corrected. Applicants thank the Examiner for noticing this error. Withdrawal of the objection is respectfully requested.

Claims 24, 25, 28 and 29 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 44 and 32 of co-pending application number 09/566,806 (the '806 application). This rejection is respectfully traversed.

In the Office Action, claim 24 is rejected on the '806 application claim 44, and claim 25 is rejected based on '806 application claim 32.

Claim 44 of the '806 application is directed to a nasal mask cushion to sealingly connect a mask to a wearer's face. The cushion comprises:

a nasal bridge region, a cheek region and a lip region;

a first membrane comprising a substantially triangularly shaped frame of resilient material having a first molded rim of said first membrane; and

a second membrane of resilient material, the second membrane being thinner than said first membrane, said second membrane having a second molded rim that is inwardly curved, said second rim spaced a first distance from said first rim in said lip region and said second rim spaced a second distance from said rim and said nasal bridge region, said second distance greater than the first distance, said distances measured when the mask is not in use, a portion of said second membrane curved rim forming a face contacting seal.

By contrast, claim 24 recites a nasal mask cushion including a first membrane comprising a substantially triangularly shaped frame of resilient material having a first molded inwardly curved rim of said first membrane, and a second membrane of resilient material. The second membrane is thinner and more flexible than the first membrane. The second membrane curved rim is spaced a distance from the first membrane curved rim, the distance being greater than a thickness of the first molded inwardly curved rim.

According to the Office Action, the differences between current application claim 24 and '806 application claim 44 are additional limitations in application claim 24 including a more flexible second membrane. However, claim 24 recites that the first membrane includes "a first molded inwardly curved rim" which is not recited in claim 44. Claim 44 recites a first membrane with a "first molded rim." In addition, claim 24 recites that the second membrane curved rim is spaced a distance from the first membrane curved rim, and that the distance is greater than the thickness of the first molded inwardly curved rim. Claim 44 does not specify that the distance is greater than the thickness of the first molded inwardly curved rim. Conversely, nor does claim 24 recite claim 44's feature that the first distance is in the lip region, that a second distance is present, that the second distance is located in the nasal bridge region, or that the second distance is greater than the first distance.

Moreover, contrary to the assertion in the Office Action, claim 24 is not anticipated by claim 44. Specifically, as can be determined from the above examples each claim recites features the other does not.

In this situation, the Examiner must identify all of the differences between the claims, and make a determination as to whether it would have been obvious to add or subtract features from

'806 claim 44 to arrive at present claim 24. The Office Action has not provided this analysis and therefore the rejection of claim 24 is improper.

Claim 32 of the '806 application, in part, recites:

a substantially triangularly shaped first membrane of resilient material having a first molded rim that at least partially surrounds a wearer's nose, at least a portion of the first molded rim being inwardly curved; and

a second membrane also of resilient material and having a second molded rim that is inwardly curved, said second molded rim being fixed to and extending away from said first membrane so as to have a second membrane inner surface spaced a distance from an outer surface of said first molded rim, a portion of said second molded rim forming a face contacting seal that is preformed to generally match the facial contours of the wearer.

By contrast, claim 25 recites that the second membrane is relatively more flexible than the first membrane, which feature is not recited in claim 32 of the '806 application. Claim 25 also recites that the second membrane has a second membrane inner surface spaced a distance from an outer surface of the first molded rim, the distance being greater than the thickness of the first molded inwardly curved rim. This feature is not found in '806 application claim 32. In addition, '806 application claim 32 recites that a portion of the second molded rim forming a face contacting seal is preformed to generally match the facial contours of the wearer. Another difference is that '806 application claim 32 recites that at least a portion of the second molded rim remains spaced from the first molded rim when the mask is connected to the wearer's face, which feature is not found in present claim 25.

The Office Action concludes that claim 25 is a generic recitation which is anticipated by the language of claim 32. However, claim 32 is missing several of the features recited in claim 25, and therefore cannot anticipate claim 25. Moreover, the Examiner has not provided any basis

or motivation why one of ordinary skill in the art would have removed the features in claim 32 which are not found in claim 25. Accordingly, Applicants respectfully submit that the rejection of claim 25 is improper.

In the Office Action, it is asserted that claims 28 and 29 are substantially equivalent in scope to claims 24 and 25. Notwithstanding this statement, and the fact that the scope of claims 28 and 29 is different from the scope of claims 24 and 25, Applicants respectfully traverse the rejection of claims 28 and 29 for reasons similar to those given above, in that the Office Action does not set forth a *prima facie* case for rejecting the claims.

Reconsideration and withdrawal of the rejection are respectfully requested.

Claims 26 and 30 were rejected under the judicially created doctrine of obviousness-type double patenting over claim 18 of U.S. Patent No. 6,112,746. This rejection is respectfully traversed.

With respect to claim 26, the Office Action points to the recitation in patent claim 18 which relates to a second membrane inner surface spaced a second distance from the first molded rim, and that the second distance is greater than the first distance. The Office Action goes on to state that claim 26 is a generic version of claim 18 and that the generic invention is anticipated by the species. Again, the Office Action has failed to identify all of the differences between the claims or to make any assertion that it would have been obvious for one of ordinary skill in the art to have modified patent claim 18 to add or remove features to arrive at pending claim 26. In the instant application, claim 26 recites a second membrane having a second molded inwardly curved rim that extends away from the first membrane so as to have an inner surface spaced a distance from the first molded rim, the distance being greater than the thickness of the first inwardly curved rim. Patent claim 18 does not include this feature and therefore cannot

anticipate claim 26. Moreover, the Office Action has not even identified this difference, much less made any assertion that it would have been obvious to include this feature in patented claim 18.

With respect to claim 30, the Office Action merely states that claim 30 is substantially equivalent in scope to claim 26 and is anticipated by claim 18 of the '746 patent. However, claim 30 recites, for example, that the second molded rim remains spaced from the first molded rim in at least one of the nasal bridge region, the cheek region and the lip region when the mask is connected to the wearer's face. This feature is not recited in patent claim 18. Accordingly, withdrawal of the rejection is respectfully requested.

Claims 27 and 31 were rejected based on claim 1 of the '746 patent. In the Office Action, it is stated that claim 1 is a species of generic claim 27. However, claim 27 specifies a second membrane being more flexible than the first membrane, which feature is not recited in patent claim 1. In addition, claim 27 recites that the second membrane curved rim is spaced a distance from the first membrane curved rim, and that the distance is greater than the thickness of the first molded inwardly curved rim, which feature is also not recited in claim 1 of the '746 patent. Therefore, claim 1 cannot anticipate claim 27. Moreover, the Office Action once again fails to identify each difference between the claims and also fails to allege that it would have been obvious to one of ordinary skill in the art to have modified patent claim 1 to arrive at the claim language of claim 27, by adding and/or subtracting features from claim 1 to arrive at claim 27.

In the Office Action, it is stated that claim 31 is substantially equivalent in scope to claim 27. Notwithstanding the statement and the fact that claims 27 and 31 have distinct scope of coverage, Applicants respectfully submit that the reasoning and rationale behind Applicants traversal of claim 27 carries through for claim 31 as well. For example, claim 31 recites that the

second membrane curved rim is spaced a sufficient distance from the first membrane curved rim such that under a normal tightening force of the mask to the wearer's face, the second membrane curved rim remains spaced from the first membrane curved rim around at least a portion of the circumference of the first membrane curved rim. This feature is not recited in claim 1 of the '746 patent, and nor is there any statement in the Office Action that it would have been obvious to one of ordinary skill in the art to have added this feature to the language of claim 1.

Reconsideration and withdrawal of the rejection are respectfully requested.


In view of the above amendments and remarks, Applicants respectfully submit that all the claims are patentable and that the entire application is in condition for allowance.

Should the Examiner believe that anything further is desirable to place the application in better condition for allowance, he is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

**NIXON & VANDERHYE P.C.**

By: \_\_\_\_\_



Paul T. Bowen  
Reg. No. 38,009

PTB:jck

1100 North Glebe Road, 8th Floor  
Arlington, VA 22201-4714  
Telephone: (703) 816-4000  
Facsimile: (703) 816-4100